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ATTORNEY DOCKET NO.

07/158,652 02/22/88 ALIZON

M PAST-010-A

EXAMINER

RAILEY, J

ART UNIT

PAPER NUMBER

8

185

DATE MAILED:

03/13/91

FINNEGAN, HENDERSON, FARABOW,
GARRETT AND DUNNER
1775 K STREET, N.W.
WASHINGTON, DC 20006

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on 29 Nov 1990 ☒ This action is made final.
A shortened statutory period for response to this action is set to expire 3 month(s), 3 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 30, 31 AND 56-106 are pending in the application.
Of the above, claims 62-106 are withdrawn from consideration.
2. ☒ Claims 11-29 AND 32-55 have been cancelled.
3. ☐ Claims are allowed.
4. ☒ Claims 30, 31 AND 56-61 are rejected.
5. ☐ Claims are objected to.
6. ☒ Claims 56-106 are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____ Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☒ not been received SEE 14.
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☒ Other THE CERTIFIED COPY OF UNITED KINGDOM APPLICATION NUMBER 8429099 HAS NOT BEEN RECEIVED. THE CERTIFIED COPY AND TRANSLATION OF FRENCH APPLICATION NUMBER 84106013 HAS BEEN RECEIVED 29 Nov 1990.

EXAMINER'S ACTION

Due to a confusion in the numbering of claims in the previous office action, paper number 4, there should have been claims 11-55 pending and claims 1-10 canceled. Although the previous office action was drawn to renumbered claims 29 and 30, the proper renumbering should have been 30 and 31, corresponding to the claims numbers 32 and 33 as submitted with the applicants' amendment, paper number 3, filed 23 September 1988. The following chart will try to clear the mistakes and bring the pending claims into focus:

<u>Applicants'</u> <u>Claim Numbers</u>	<u>Paper 4</u> <u>Claim Numbers</u>	<u>Correct Numbers</u> <u>Under Rule 126</u>	<u>Current</u> <u>Status</u>
1-10	1-10	1-10	canceled
13-57	11-54	11-55	see below
(13-31)	(11-28)	(11-29)	canceled
(32)	(29)	(30)	pending
(33)	(30)	(31)	pending
(34-57)	(31-54)	(32-55)	canceled
58-108	-----	56-106	pending

The examiner thanks the attorney in advance for understanding in this matter and the new claim numbers under Rule 126 will be used henceforth.

The cancellation of claims 11-29 and 32-55 in paper number 7 filed 29 November 1990 is acknowledged.

Newly submitted claims 62-106 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The amino acid sequences and compositions described in claims 62-106 are independent inventions from the DNA sequences of claims 30, 31 and 56-61. The amino acid sequences and compositions have separate utility as vaccines.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 62-106 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and

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M.P.E.P. § 821.03.

Newly submitted claims 56-61 are examined here.

Claim 30 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the entire sequence as set forth in claim 30. See M.P.E.P. §§ 706.03(n) and 706.03 (2).

The rejection is maintained for reasons set forth in the prior office action. Although applicant states in paper number 7, page 25 that the claim no longer recites "at least a portion" of the sequence, there is no actual amendment to the claim submitted.

Claims 30, 31 and 56-61 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection is maintained for reasons set forth in the prior office action and for reasons given in the above paragraph.

Claim 30 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

Claims 31 and 56-61 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier

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communications from the examiner should be directed to J.F. Railey whose telephone number is (703) 308-0408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Johnny F. Railey II
March 9, 1991



RICHARD A. SCHWARTZ
SUPERVISORY PATENT EXAMINER
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